

Application Serial No.: 09/913,906
Amdt. dated October 4, 2006
Reply to Non-Final Office Action of April 4, 2006

REMARKS/ARGUMENTS

The Office Action dated April 4, 2006 and the references cited therein have been carefully considered. In response to the Office Action, Applicant has amended the Specification and Claims 1, 19-25, 27-28 and 32 which, when considered with the remarks set forth below, are deemed to place the case in condition for allowance.

In the Office Action, the Examiner has first finalized the Restriction Requirement and has, therefore, withdrawn Claims 2-18, 29-31, 34-37 and 39-41. This leaves Claims 1, 19-28, 32 and 33 pending in the present application.

Also in the Office Action, the Specification has been objected to for making references to the claims. In response, Applicants have amended the Specification to eliminate the references to the claims and substitute therefor the subject matter of the respectively referenced claims. Accordingly, it is believed that the Specification objection has been overcome.

Further in the Office Action, Claims 1, 19 and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over PCT publication No. WO 98/19305 to Butcher in view of U.S. Patent No. 5,189,531 to Palmer et al. and Examiner Official Notice. In particular, the Examiner states that the Butcher publication discloses a method of manufacturing a storage device including the step of adding information into holograms of the storage device for the purpose of in-store security tagging. The Examiner is also of the opinion that the limitations of Claims 1 and 19, relating to the specific product information of the protective means, do not confer patentable limitations on the claims.

The Examiner has also rejected Claims 21-28, 32 and 33 under 35 U.S.C. §103(a) as being unpatentable over the Butcher publication in view of the Palmer patent and Examiner Official Notice and further in view of U.S. Patent No. 4,978,005 to Sammet. Specifically, the Examiner states that the Sammet patent discloses adding printing to a storage device and that the method steps of adding such printing during an in-mold labeling procedure is well known

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in the art. In this regard, the Examiner further cites U.S. Patent No. 5,082,435 to Kuramitsu et al., U.S. Patent No. 4,639,341 to Hanamoto et al. and U.S. Patent No. 5,254,302 to Yamanaka as extrinsic evidence of well known in-mold labeling techniques.

In response, Applicants have amended independent Claims 1 and 19 to further define the features of the present invention. The amendment to Claims 1 and 19 will be discussed separately below.

Claim 19

Applicants have amended independent Claim 19 to define a method for forming a plurality of storage devices for data carriers wherein a protective means is incorporated into the storage device, which is unique to the data carrier stored in that particular storage device. More specifically, Claim 19 defines a method for manufacturing storage devices including the steps of placing a first protective means in a mold and subsequently forming at least a portion of a first storage device and then placing a second protective means in the mold and forming at least a portion of a second storage device, wherein the first and second protective means have product information specific to the respective data carriers to be stored in the storage devices and, wherein the product information of the first protective means is different from the product information of the second protective means. It is respectfully submitted that none of the cited prior art references, taken alone or combined, discloses this feature.

In this regard, it is important to note that Applicants are not attempting to claim the specific product information or content of the indicia of the protective means itself. Instead, Applicants are simply claiming a manufacturing method for producing data carrier storage devices including the step of providing different product information to successive storage devices for improved authentication purposes. Accordingly, it is respectfully submitted that the Examiner's position regarding the lack of patentable limitations with respect to printed matter is inapplicable to method Claim 19, as amended.

Claim 1

Applicants have also amended independent Claim 1 to define a storage device having a protective means incorporated therein during a molding process, wherein the protective means includes specific product information incorporated therein which is specific to the data carrier to be stored in the particular storage device. It is respectfully submitted that none of the cited prior art references taken alone or combined discloses this feature.

It must first be noted that in prior art storage devices for CD's/DVD's to be stored therein, there has heretofore been no relationship between the storage device and the particular CD or DVD to be stored therein. At best, the storage cases are provided with universal, identical tags, which will activate an anti-theft alarm system if the case is carried past a detector. No link is provided between the CD/DVD and the box, except for, perhaps, a loose label inserted, which can easily be removed and/or copied and/or counterfeited.

According to the present invention the box itself is used as an authentication means for the CD/DVD. To that end the box is made dedicated to the specific CD or DVD, which, by the way, requires a specific manufacturing procedure. Therefore the concept of the present invention is totally different than the anti-theft devices disclosed in the cited prior art.

It is respectfully submitted that there is no teaching or suggestion in the prior art to combine the references as suggested by the Examiner and, even if one skilled in the art were somehow motivated to combine the cited references, such combination would not result in the claimed invention. It is well settled that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Additionally, when applying 35 U.S.C. §103, the references must suggest the desirability and thus the obviousness of making the combination without the benefit of impermissible hindsight vision afforded by the claimed invention. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986). Thus, it is improper hindsight merely to "pick and choose" components from the prior art references to arrive at the claimed invention. There

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must be a suggestion in the prior art references to combine the components as recited in the claimed invention. *See MPEP §2141 - §2143.*

First, the Butcher patent only discloses the use of a hologram for anti theft purposes. On page 10, lines 27 of the Butcher patent it is indicated that embossing of a decoration can be provided in a single molding process, and it is later stated that holograms can be added for in store security. Again, there is no mention in the Butcher patent of providing a direct link between a specific CD/DVD and the storage box in which the CD/DVD is to be stored.

Moreover one skilled in the art would recognize, at the time of filing of the present invention, that the method for providing the hologram in the Butcher patent does not involve an in-mold labeling technique, as set forth in the claims. Instead, it appears from the disclosure in Butcher that the hologram is provided as a sticker, which can easily be removed from the storage box. With respect to such in-mold labeling, while it may be true that providing printing by in-mold labeling is known, it has been heretofore unknown to provide an authentication means, as set forth in the claims.

With respect to the Examiner's request for clarification of the subject matter of Claims 21-28, 32 and 33, Applicants submit that the subject matter of these claims is related to the inventive concept of authenticating CD's/DVD's and boxes and for that purpose it is both new and inventive.

Accordingly, for all of the reasons set forth above, it is respectfully submitted that independent Claims 1 and 19 and the Claims that depend therefrom, patentably distinguish over the prior art.

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In view of the foregoing amendment and remarks, favorable consideration and allowance of the application are respectfully solicited. If the Examiner believes that a telephone interview would assist in moving the application toward allowance, he is respectfully invited to contact the Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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